

APR 10

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Application Number	10/765,106
Filing Date	01/28/2004
First Named Inventor	Richard D. Ferris
Art Unit	3711
Examiner Name	Blau
Attorney Docket Number	FERR-004
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## ENCLOSURES (Check all that apply)

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Welsh & Flaxman LLC		
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Date	11/13/2007	Reg. No.	33,621

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Richard D. Ferris

Group Art Unit: 3711

Serial No.: 10/765,106

Examiner: Blau

Filed : 01/28/2004

Title : HANDLE CONFIGURATION FOR A PUTTER TYPE GOLF CLUB

**REQUEST FOR REHEARING UNDER 37 C.F.R. 41.52**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

On September 20, 2007, a Decision on Appeal was issued by the Board of Patent Appeals and Interferences in the above-referenced patent application. In accordance with 37 C.F.R. 41.52, Appellant respectfully requests a rehearing of the decision issued September 20, 2007. This request is being filed within two (2) months of the Decision date and is deemed proper.

The Board has misapprehended the references to Takeuchi for the following reasons:

- 1) The Board has incorrectly implied "the grooves making the graduations form four angle quadrants" (Page 12, lines 14-15, of the 09/20/2007 Decision);
- 2) The Board incorrectly states, "While the grooves in Fig. 3 do not intersect in a cross, they do form four quadrants and performed the same function as the claimed indicia" (Page 12, lines 15-17, of the 09/20/2007 Decision);
- 3) The Board incorrectly states, "There is no functional difference between the arrangement taught by Takeuchi and that recited in claim 1 other than a printed design

feature (i.e. non-intersecting lines versus intersecting lines)” (Page 12, line 17 through Page 13, line 1 of the 09/20/2007 Decision);

- 4) The Board incorrectly states, “Whether the lines intersect or not has no functional relationship with substrate, and this we do not consider the difference to distinguish the claimed feature from that disclosed by Takeuchi” (Page 31, lines 1-4 of the 09/20/2007 Decision); and
- 5) The Board’s reasoning on Page 13, lines 5-16, is not supported by *KSR Int’l Co. V Teleflex Inc.*, 127 Ct. 1727, 82 USPQ2d 1385 (2007).

### **MISAPPREHENSION 1**

With regard to the first misapprehension, the Board correctly states Takeuchi discloses great graduations at 45 degree angles. However, great graduations at 45 degrees in a 360 degree circle results in the formation of eight (8) quadrant angles, not four as stated in the Decision. It is inconceivable how one can look at the indicia of Takeuchi and see only four quadrant angles.

Regardless, Appellant claims two lines intersecting to form four angles, not four quadrant angles. Intersecting lines is what the invention and claims require, as without the intersecting lines the indicia would not be usable as a sight for aligning the striking face of a golf club head with a target.

### **MISAPPREHENSION 2**

With regard to the second misapprehension, the Board incorrectly states, “[w]hile the grooves in Fig. 3 do not intersect in a cross, they do form four quadrants and performed the same function as the claimed indicia”. As stated above, the indicia of Takeuchi does not form four

quadrant angles. More importantly, the indicia of Takeuchi does not perform the same function as Appellant's claimed intersecting indicia.

In contrast to the Board's characterization, the indicia or reference graduations of Takeuchi are used to align a non-circular grip on the shaft relative to the club face. The indicia or reference graduations of Takeuchi are not used to align the club face relative to a target for the execution of a shot.

The grip of Takeuchi is not circular (see Figure 2) and includes a "back line of grip in the form of a slightly thickened ridge" (see "element 2"). In view of the non-circular shape of the grip disclosed by Takeuchi, it is necessary to properly position the grip upon the club to ensure optimal usage and Takeuchi's invention specifically relates to the alignment of element 2 of the grip relative to the club face as the club is being custom built for a particular golfer.

As such, the function of the indicia on the butt end of Takeuchi is to align the thickened back line ridge relative to the club face when the grip is being permanently applied to the shaft. The individual small and large graduations allow the fabricator to easily choose the desired angular position for placement of the back line ridge relative to the club face. At Column 4, line 57, to Column 5, line 2, Takeuchi provides an example for creating a 22.5 degree hook angle grip. In accordance with this example, the back line ridge is permanently positioned at 22.5 degrees relative to the striking face, causing the golfer to grip the club to compensate for a hook swing. That is, and as those skilled in the art of golf club fabrication and the play of golf will certainly appreciate, depending upon one's natural swing one may need to adjust his or her hand position to compensate for a natural hook or slice.

Ergo, the function performed by the indicia of Takeuchi is not the same or even equivalent to the function of the indicia claimed in accordance with the present invention. As such, the indicia of Takeuchi do not and cannot function in the manner applied by the Board. That is, there is no reason to believe the graduations of Takeuchi would be oriented to provide for a target line perpendicular to the striking face of the golf club.

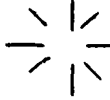
### **MISAPPREHENSION 3**

With regard to the third misapprehension, the Board states “[t]here is no functional difference between the arrangement taught by Takeuchi and that recited in claim 1 other than a printed design feature (i.e., non-intersecting lines versus intersecting lines)”. As pointed out above, there is a huge functional difference between that claimed in accordance with the present application and that disclosed by Takeuchi. The indicia disclosed by Takeuchi cannot perform the function invented by Appellant.

The functional difference between the intersecting cross alignment lines claimed and the graduations of Takeuchi must have been misunderstood. Appellant is not concerned with positioning a golfer’s grip on the club to alter their shot or compensate for a natural hook or slice swing. Appellant is concerned with properly positioning the club head at a desired target and swinging the club head relative to the ball toward the desired target. Appellant’s indicia form cross hairs much like those used in a gun scope when aiming a gun at a desired target. Appellant’s cross hairs assist in aligning a shot to a desired target. This is not the same or equivalent to the provision of graduations to assist a club fabricator in aligning one’s golf club grip relative to a club head as contemplated by Takeuchi. Appellant’s indicia function as cross hairs to align a shot relative a target, similar to a gunning site permitting one to align a gun barrel relative to a target. It would be

extremely difficult to use a gun sight that looks like a clock having numerous graduations about its perimeter to aim at a target, as the operator would be extremely confused as to what graduations should be used to lock onto the target.

#### **MISAPPREHENSION 4**

With regard to the fourth misapprehension, the Board contents “[w]hether the lines intersect or not has no functional relationship with the substrate, and this we do not consider the difference to distinguish the claimed feature from that disclosed in Takeuchi”. Appellant is confused as to how the relationship of the indicia relative to the substrate is relevant, as it has nothing to do with the claimed invention. Second, this statement is wholly unsupported. Whether two lines intersect to form a sight has a noteworthy functional relationship with regard to the substrate. Four quadrants just don’t function the same or anywhere near equivalent to two intersecting lines. As discussed above, it would be extremely difficult to use a gun sight that looks like this , as the shooter would not know what lines to use to aim at the target. They would not be able to determine horizontal relative to vertical which is a necessary part of sighting cross hairs to a target.

#### **MISAPPREHENSION 5**

With regard to the fifth misapprehension, the Board’s application of KSR is improper. The question at hand is not whether a patent claiming the combination of elements of the prior art is obvious, nor is it whether the improvement is more than the predictable use of prior art elements according to their established functions. In the case at hand the combination of references cited by the Examiner fails to disclose all the elements of Appellant’s claims. Thus, we are not dealing with a combination of prior art elements disclosing all of the elements of the claims. If they are not shown in the cited prior art, it is impossible to determine whether they represent a predictable use.

Takeuchi does not, contrary to what the Board states, describe “a sighting device forming four angle quadrants for the purpose of demarcating the target directional line”. The indicia on Takeuchi does not perform the function of demarcating the target directional line. The indicia on Takeuchi merely aid a fabricator in securing a grip to a club by aligning element 2 relative to the club face to customize the club for a particular golfer’s swing.

There is no showing that Appellant’s “improvement is more than the predictable use of prior art elements according to their established functions”. The Board states “...the prior art of Takeuchi describes a sighting device forming four angle quadrants for the purpose of demarcating the target directional line”. Takeuchi does no such thing. Such a description is found nowhere in the disclosure of Takeuchi. In fact, Appellant has previously pointed out Takeuchi has no desire to have these graduations perform the function of demarcating the target directional line. In order to perform this function the lines would need to intersect and be oriented perpendicular to the striking face. Neither of which are contemplated by Takeuchi. Appellant, at Page 11, lines 12-20, of its Brief, states:

Takeuchi does show lines 5a, 6, 7 and 8 on the end of a golf club handle, but none of these lines intersect. In fact, Takeuchi has no desire for the indicia lines to intersect as intersecting lines would be contrary to Takeuchi’s invention. The length of Takeuchi’s lines are different for a reason, this is so one can easily distinguish the angular intervals when adjusting the grip’s position. For example, short lines 8 indicate 11.25 degrees, slightly longer lines 7 indicate 22.5 degrees, long lines 6 indicate 45 degrees and lines 5a function as references lines. When fitting the grip of Takeuchi on a shaft, the angle of the grip can be easily determined by knowing the distinction between the length of the grad[u]ation lines. However, if the lines intersected they would no longer function as grad[u]ations, as the lines would not be readily distinguishable from one another.

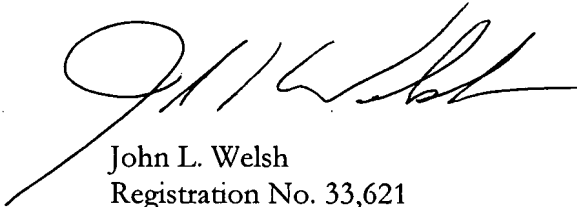
As discussed above, Takeuchi does not have four quadrant angles for the purpose of demarcating the target directional line. If anything, Takeuchi has eight quadrant angles, which,

whether four or eight, has no bearing as these angles do not create intersecting lines. They do not perform the function of demarcating a target line (as they are not oriented perpendicular to the striking face). The lines on Takeuchi are not for demarcating a target line and, contrary to the Board's statement, the fact they do not intersect does change their function and cannot merely be dismissed as a stylized design choice.

Appellants' invention performs a function not previously recognized in the prior art. Thus, it cannot be a predictable result and cannot merely be dismissed as a stylized design choice, when the form, function and location of Appellant's indicia is what results in its novelty.

In view of the above, Appellant has clearly pointed out how the reference to Takeuchi was misinterpreted and relied upon for something it does not teach, and has pointed out how the decision is not supported by current law.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. L. Welsh', with a long horizontal stroke extending to the left.

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Our Docket No. FERR-004